

REMARKS

Request for Corrected Form 892 and Corrected Copy of References

Counsel for applicant notes that certain references were incorrectly cited in the Form 892 and/or an incorrect copy of such references was provided, in connection with the Office Action. The Examiner is thanked for the courtesy of the discussion when the incorrect citations were brought to the attention of the Office, and for supplying a corrected form 892, in which references U and V (page 1) were corrected and reference U (page 2) was added.

Nevertheless, issues with the cited references require further correction.

Inventnet.com (Reference U2) is cited without a print date or publication date. This document includes what appears to be a print date of "1/22/03." Certain pages of the references mention copyright dates of 2002. It is respectfully submitted that the citation of the *Inventnet.com* (Reference U2) requires correction to reflect a print date or publication date.

PCT-East, User Reference Manual, PCT-EASY V 2.80, World Intellectual Property Organization (www.wipo.int/) (Reference W1) apparently cites two separate documents: a manual and a web page. No copy of the cited web page was provided. It is respectfully noted that each document requires a separate citation, and it is requested that a copy of the cited web page be provided.

Since the citations are incomplete, counsel for applicant respectfully points out the rules and regulations governing citations. 37 CFR § 1.104(d), MPEP § 707.05(e), MPEP § 901.05(a). Accordingly, the Examiner is respectfully requested to provide the available information, rather than withholding it from applicant. For example, if the references are available over the Internet, the Examiner is requested to provide an appropriate citation so that the references may be reviewed in their entirety. On the other hand, if the references are considered to be printed publications, the Examiner is respectfully requested to provide a print date and other appropriate citation details.

A further letter correcting the errors together with a correct copy of the references and a corrected form 892 is respectfully requested. MPEP § 707.05(g).

The claims stand rejected under 35 U.S.C. § 103(a) which requires that the subject matter

"would have been obvious at the time the invention was made." As the Examiner is well aware, references dated subsequent to the filing date of the application, i.e. December 14, 1999, cannot be used in a rejection under 35 U.S.C. § 103(a). Hence, applicant will not respond to those portions of references that are apparently unavailable for use in the rejection.

The Rejection

In the Office Action mailed January 30, 2003, the Examiner rejects claims 1- 24 over various references including newly cited references. The rejections are respectfully traversed for the reasons indicated below. Reconsideration of the application and withdrawal of the rejections are respectfully requested.

Claims 1 - 24 remain in the case.

Claims 1 – 24 stand rejected under 35 USC §103(a) as being unpatentable over a combination of Brown, Pinnisi & Michaels, PC (www.lightlink.com/bbm, Screen Print 1/18/1999) ("BPM"), in view of InventNet (Internet Archive WayBack Machine, www.inventnet.com, Screen Print 12/3/1998 – 2/9/1999) ("InventNet"). For the reasons including, inter alia, those discussed below, each of independent claims 1, 8, 11, 15, 21 and 24 is patentable over the applied reference. Moreover, each of the claims dependent therefrom is patentable.

The Claimed Invention

As described in the application, the invention is directed to solving the problem of seeking protection for intellectual property assets, potentially in multiple jurisdictions. Intellectual property owners are faced with a landscape of national requirements-based and foreign associate-based variations in formal or procedural requirements. In spite of the magnitude of the problem and the need for a solution, prior art devices simply have not solved this problem. "Recognizing the limitations of currently available systems, a facility has been developed whereby an applicant (or his representative) may initiate performance of an intellectual property service such as the making of a maintenance fee, annuity, renewal, tax or other payments and transact the associated fees coincident therewith. . . . Outside the context of annuity-type payments, similar facilities

may be employed in conjunction with preparation, filing and prosecution support tools to similarly transact fees associated with the performance of intellectual property services at or about the time such intellectual property services are performed.”

The invention, as claimed, is directed to a method for transacting an intellectual property service in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions (claim 1); a method for transacting intellectual property annuity, maintenance or renewal fee payments (claim 8); a method of operating an information service to facilitate fee transactions in connection with the filing of documents and/or payment of fees relating to intellectual property services (claim 11); an information system for transacting fees associated with intellectual property services in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions (claim 15); a computer program for transacting an intellectual property service in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions (claim 21); and an intellectual property filing preparation system (claim 24); all as further claimed.

By way of example, one element of claim 1 as amended provides for “providing a user with information representative of one or more intellectual property services and one or more fees associated therewith, wherein the fees include one or more of: official fees and service fees.” As another example, an element of claim 8 as amended calls for “providing, responsive to docket data, information representative of one or more intellectual property matters and one or more fee payments associated therewith...” Further, claim 11 as amended includes the element of “registering for each of plural associates, at least one target jurisdiction and a computer readable encoding of fees for one or more intellectual property services performed by the associated therein.” Claim 15, as amended, includes by way of example, “an intellectual property service portal coupled by the network to the originating node and one or more of the target nodes, the intellectual property service portal responsive to a selection at the originating node of at least one intellectual property service, supplying the originating node with information representative of one or more fees corresponding to the selected at least one intellectual property service...” As another example, claim 21 as amended concerns “a computer program product encoded in a computer readable medium for transacting an intellectual property service”.

Claims 1-21, 24: BPM and InventNet

In the present Office Action, claims 1-21 and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over InventNet and BPM. Further, claims 22 and 23 stand rejected over BPM and InventNet in combination with other references. The rejections are respectfully traversed.

BPM concerns a collection of web pages, apparently produced by a US intellectual property firm, with some information about intellectual property. The portions provided by the Examiner include, *inter alia*, a page titled "Invention Disclosure Form;" a page titled "Patent Information"; a page titled "Budget Estimator for Patents;" and portion of a page titled "IP Resources on the Internet." The Office Action admits that BPM fails to disclose one or more target jurisdictions.

There are numerous other deficiencies of BPM, including by way of example that BPM fails to teach or suggest selection by a user of one or more of the intellectual property matters and associated one or more fee payments.

Recognizing that BPM fails to teach or suggest the invention as claimed, InventNet is cited. Nevertheless, for reasons including the following, InventNet fails to remedy such deficiencies.

Inventnet claims to be an Internet based inventor's network. The Office Action argues that Inventnet "teach the registration and selection of one or more target jurisdictions." Assuming *arguend*, without admitting, that InventNet provides the teaching as contended in the Office Action, it is not clear how the registration of one or more target jurisdictions and/or selection of one or more target jurisdictions would teach or suggest the registration and/or selection of one or more intellectual property services (claims 1, 15, 21, 24), or of intellectual property matters (claim 8), or of jurisdiction and fees for intellectual property services (claim 11). Furthermore, it appears that the Office Action cites a single element of InventNet and BPM as corresponding to different claimed elements. This is a strong indication that the reference fails to teach or suggest the invention as claimed, for these claims.

Hence, Inventnet and BPM, alone or in combination, fail to teach or suggest the combination of features recited in the claims.

Furthermore, Inventnet and/or BPM operate in a fundamentally different way than the claimed invention. Specifically, neither Inventnet nor BPM teach or even suggest, let alone

disclose, anything concerning the registration and/or selection of one or more intellectual property services (claims 1, 15, 21, 24), or of intellectual property matters (claim 8), or of jurisdiction and fees for intellectual property services (claim 11). Consequently, the proposed combination fails to teach or suggest the claimed invention.

In addition, there is no suggestion or motivation to combine the references. The Office Action provides no motivation to combine the references, other than a statement in paragraph 8 that the combination would be made "for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities by offering intellectual property services in a multitude of jurisdictions (US and foreign)." Inventnet itself does not provide a motivation to combine its materials with BPM, nor does BPM provide a motivation to offer inventor group materials of any type. To the contrary, InventNet teaches that its users use a patent attorney to prepare the necessary documents ("Patenting Help" page screen).

Assuming *arguendo*, without admission, the suggested motivation, the proposed combination of references still fails to teach or suggest the invention as claimed. For example, the combination of Inventnet and BPM still fail to provide "initiating performance of the selected one or more intellectual property services, and ... transacting the associated one or more fees" (claim 1, see also claims 21 and 24); "in response to selection by a user of one or more of the intellectual property matters and associated one or more fee payments, initiating performance of the one or more fee payments, and ... initiating a payment transaction corresponding to the selected one or more fee payments between the user and an intellectual property annuity, maintenance or renewal fee payment service" (claim 8); "registering for each of plural associates, at least one target jurisdiction and a computer readable encoding of fees for one or more intellectual property services performed by the associate therein" (claim 11); or "supplying the originating node with information representative of one or more fees corresponding to the selected at least one intellectual property services, ... transacting the one or more fees substantially coincident with the initiation thereof" (claim 15).

Moreover, assuming *arguendo*, without admission, that it may have been possible to access both over the Internet, that in itself provides no motivation to combine the references in the

manner proposed by the Examiner.

With regard to independent claims 1, 8, 11, 15, 21 and 24, the Office Action again fails to specify the reasons for rejection particular to each claims.¹ Further, the Office Action fails to cite any particular portion of any reference supporting the rejection.² If the Examiner maintains this rejection, he is respectfully requested to remedy the lack of citation and reasoning, so that applicant may respond substantively thereto.

For at least these reasons, the combination of features recited in independent claims 1, 8, 11, 15, 21 and 24, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Teaching Away

A prior art reference must be considered in its entirety, including portions that would have lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied* 469 US 851 (1984). Where the reference teaches away from the claimed invention, it is a significant factor and must be weighed in substance. Further, known disadvantages in old devices would naturally discourage a search for new inventions, and must be taken into consideration in determining obviousness. United States v. Adams, 383 US 39, 52, 148 USPQ 479, 484 (1966).

BPM discloses that providing estimated fees and costs is almost impossible. Specifically,

¹ The omnibus rejection of independent Claims 1, 8, 11, 15, 21 and 24 in paragraphs 5-8 of the office action is respectfully traversed. It appears that the rejection is applied only to claim 8. According to the MPEP, "a plurality of claims should never be grouped together in a common rejection, unless that rejection is *equally applicable* to all claims in the group." MPEP § 707.07(d). Nevertheless, counsel for applicant will respond as best understood, in order to advance prosecution.

² Counsel for applicant respectfully traverses the failure of the Office Action to cite a specific location in a reference for support. If the Examiner maintains the rejections, he is respectfully requested for each and every rejection to provide specific locations in the references. Accordingly, the Examiner is again respectfully requested to provide the required citations to a particular part of the reference(s). 37 C.F.R. § 1.104(c)(2).

BPM states:

Many of our clients have asked for a way of estimating what costs and time periods to expect when pursuing a patent on their inventions. This estimator should serve as a guide, and *is as good an estimate as we can prepare, but you should realize that the fees you will actually pay may vary widely* from these, depending on the individual circumstances of your invention.

...

BPM states the following about Foreign Filing:

In general: *It is not really possible to accurately estimate the total cost of foreign filing in a generalized way, since it varies so widely depending on what countries are chosen, what method of filing is pursued, the fees of foreign patent attorneys in each country, exchange rates, translations, etc. ... We can try to give you an estimate for your specific situation based on your fact pattern, once you have a US application on file.*

BPM teaches that fees cannot be provided as claimed. BPM states "It is not really possible to accurately estimate" "We can try to give you an estimate for your specific situation ..." (Emphasis added.) A prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. A reference teaching away is highly relevant and is a significant factor to be considered in determining obviousness. The known and acknowledged difficulty of providing estimates is highly relevant. It appears that these known disadvantages would naturally have discourage a search for a new invention providing and acting upon specific fees as claimed.

Hence, the disclosure of BPM would have lead a person of ordinary skill in the art away from the use of fees and costs which are sufficiently definite that they can be transacted.

Impermissible Hindsight

The content of the prior art is determined at the time the invention was made to avoid impermissible hindsight. "It is difficult but necessary that the decision maker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who

is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. Denied* 469 US 851 (1984).

Where the reference originally relied upon by the Examiner includes or incorporates matter dated *after* the application filing date, clearly the Examiner is applying impermissible hindsight. The original Inventnet reference (prior to correction) included the following matter dated after the application filing date:

- (a) page 1, listing "waybackmachine" and "Search Results for Jan 01, 1996 – Jan 27, 2003" has a print date (lower right hand corner) of "1/27/03";
- (b) page 11 has a print date of "1/27/03"; and
- (c) pages 12-16 have a print date of "1/22/03", and elements titled "New Patent Fees starting October 2001", "Images from Yankee Invention Exhibition 2000", and "Copyright © 1995-2002".

The Inventnet reference is located in an Internet archive, at "<http://web.archive.org/web/19981206010357/www.inventnet.com/page1.html>" (see URL on Inventnet, page 2). Assuming *arguendo*, without admission, that at least pages 2, 3, 9 and 10 of Inventnet were, in fact, printed on the alleged print date of November 11, 1998, it is apparent that the Examiner accessed the archive and attempted to link to other web sites. One of the web sites was linked to and printed from on January 22, 2003 and includes a copyright date of 2002. The Examiner considered references dated 2002 or 2003 in making the rejection.

Further, the revised Form 892 still includes this reference, which clearly has been relied upon by the Examiner.

Plainly the Examiner has not considered the content of the prior art *at the time the invention was made*, and has made his determination based upon the content of the art after the filing date of the present application. Use of such art is clearly an impermissible application of hindsight. The Examiner is respectfully requested to reconsider and withdraw the rejections.

Claims 22, 23: U.S. Patent 5,819,092 (Ferguson) and U.S. Patent 6,298,327 (Hunter)

In the present Office Action, claims 22 and 23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ferguson and Hunter in combination with other reference(s). The rejection,

insofar as it might be applied to the claims, is respectfully traversed.

Ferguson concerns an online service development tool with fee setting capabilities. It is addressed to creating a sophisticated commercial online service with the ability to define fee structures for accessing parts of the online system and/or ordering other goods or services that usually requires specialized programming (e.g., Col. 3, lines 56-61). In the first Office Action, the Examiner admits that Ferguson has nothing to do with intellectual property.

Ferguson does not teach or suggest, interalia, specifics of the online services to be delivered thereby.

Hunter discloses a computer-implemented expert support system for authoring invention disclosures and evaluating patentability/marketability of an invention. Hunter does not discuss the actual filing of the application, nor does Hunter discuss anything concerning fees associated with the filing. Indeed, any discussion of filing or fees in Hunter would be premature, since Hunter is directed to the problem of enabling “inventors to adequately disclose (communicate) the characteristics of their inventions.” (Col. 2, lines 43-45.)

Ferguson is directed to an online service development tool with a fee setter subtool. Hunter is directed to an expert system for authoring an invention disclosure. Consequently, Ferguson and/or Hunter operate in a fundamentally different way than the claimed invention. Specifically, neither Ferguson nor Hunter teach or even suggest, let alone disclose, anything concerning intellectual property services in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions, as claimed.

Moreover, the Examiner still fails to provide a suggestion or motivation to combine the references themselves, or with BPM and Inventnet. Assuming arguendo, without admission, a motivation to combine the four references, the proposed modification would appear to change the principle of operation of either Hunter or Ferguson, or both. Ferguson does not appear to be appropriate to use with an expert system, as taught by Hunter. Further, Hunter does not appear to be appropriate for use as a third party content provider, as taught by Ferguson. Hence, the proposed combination would appear to require a substantial re-design of Ferguson, as well as some basic changes to the principles upon which Ferguson operates in order to accommodate an expert system. Moreover, the proposed combination fails to make obvious the invention as

claimed. Examples were previously provided as to some of the deficiencies that remain in the proposed combination, if made.

Moreover, assuming *arguendo*, without admission, that it may have been possible to access both over the Internet, that in itself provides no motivation to combine the references as proposed by the Examiner.

Summary

For at least these reasons, the combination of features recited in independent claims 1, 8, 11, 15, 21 and 24 when interpreted as a whole, is submitted to patentably distinguish over the prior art.

With respect to the rejected dependent claims, Applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 8, 11, 15, or 21, but also because of additional features they recite. Examples of some of these features were discussed above.

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant's assumption *arguendo* of a position does not constitute a concession of the Examiner's contention. Furthermore, Applicant does not concede that the cited prior art shows any of the elements recited in the claims.

However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Conclusion

For all the reasons advanced above, Applicant respectfully submits that the rejection of claims 1-24, insofar as it may be applied to the claims as amended, must be withdrawn. Consequently, issuance of a Notice of Allowance is respectfully requested.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fee that may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 08-0219.

Respectfully submitted,



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